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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/535,137

01/25/2006

Leif Andersson

15090NP

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07/09/2007

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EXAMINER

COOLEY, CHARLES E

ART UNIT

PAPER NUMBER

1723

MAIL DATE

DELIVERY MODE

07/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/535,137

Applicant(s)

ANDERSSON ET AL.

Examiner

Charles E. Cooley

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12 and 14 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **FINAL OFFICE ACTION**

### ***Priority***

1. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All of the CERTIFIED copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

### ***Drawings***

2. The replacement sheets of drawing filed 12 APR 2007 are approved.

### ***Specification***

3. The amended title and abstract are approved.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

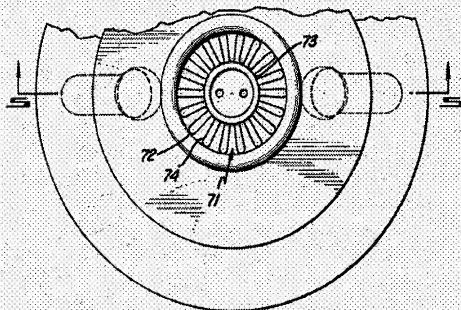
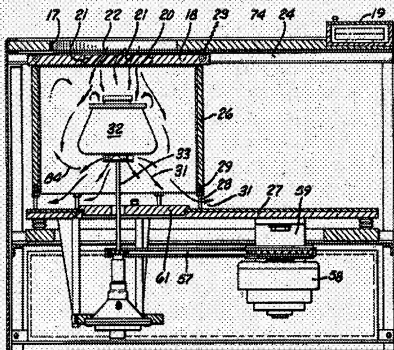
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

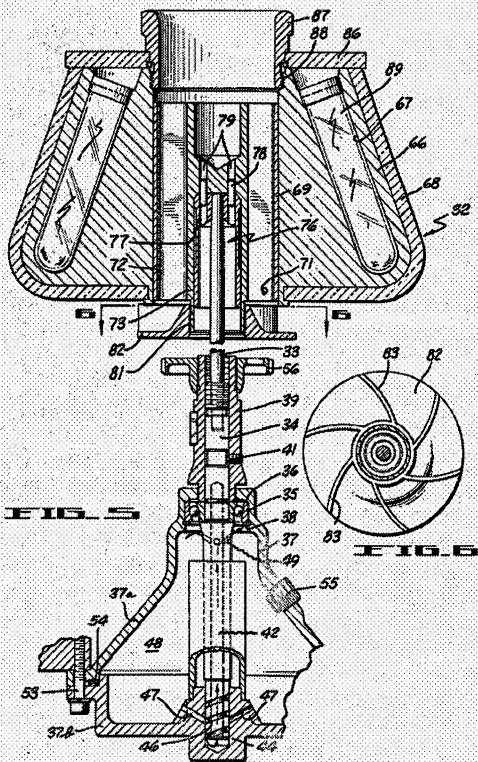
5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**6. Claims 1-9, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pickels et al. (US 2,878,992) in view of WO 00/58013.**

The patent to Pickels et al. discloses as seen below a device for centrifuging including rotor means 32 with thermal treating means for thermally treating centrifuging reaction vessels 89 containing samples in a thermocycling device; the rotor means 32 comprises at least one fan blade 71 and/or 83 which force ambient gas to through the rotor means and pass in heat exchange relationship the samples (e.g., to cool the rotor and inherently the contents or samples therein - col. 3, lines 20-22); at least one gas conducting passage 69 is arranged in the rotor means 32; wherein the rotor means 32 comprises a base portion (above 82) and a lid portion 86, 87, in between which an inner space 69 is formed wherein the fan blades 71 and/or 83 are arranged; the lower region of the rotor means 32 is provided with at least one through hole (above 82); the upper region of the rotor means 32 is provided with at least one through hole 87; the fan blades 71 are arranged at the inside of the base portion of the rotor means 32; wherein the fan blades 71 are arranged at the inside of the lid portion 86, 87 of the rotor means 32; a plate 86; the gas is ambient air (col. 3, lines 41-49).





However, Pickels et al. '992 does not disclose the particular sample reaction vessels in the form of at least one microtitre plate, now a positively claimed element of the recited "assembly". WO 00/58013 discloses a device for centrifuging including rotor means 1 with thermal treating means for thermally treating (heating or cooling) centrifuging reaction vessels 2 and teaches the equivalence between sample tubes and microtitre plates for use as the sample receptacles 2 in the rotor means (see page 10, first paragraph). In view of these teachings, it would have been obvious and mere common sense to one having ordinary skill in the art, at the time applicant's invention was made, to have substituted the sample vessels in Pickels et al. with alternative sample vessels such as microtitre plates as a function of the type of samples being processed or the desired quantity of samples to be processed (e.g., to enable the processing of many samples in the microtitre plates vs. just one sample in a tube).

**7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pickels et al. (US 2,878,992) in view of WO 00/58013 as applied to claim 1 above and further in view of Kubota (US 4,193,536).**

Pickels et al. (US 2,878,992) does not disclose the cooling means. The patent to Kubota discloses a centrifuge with a rotor means 21 for centrifuging samples 24 in a housing 11. Embodiments utilizing ambient air as a cooling gas are depicted in Figs. 1-6, however, the embodiment of Fig. 7 teaches that the gas may be passed through a cooling means 85 and introduced into the centrifuge for cooling purposes. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was

made, to have provided the centrifuge of Pickels et al. (US 2,878,992) with a cooling means for the gas for the purposes of employing gas other than air (such as inert gas) or to reduce the temperature of the centrifuge to lower than that of the ambient air/room temperature and to lower the noise emissions from the centrifuge (col. 2, lines 43-49 and col. 8, lines 3-37).

### ***Allowable Subject Matter***

8. Claim 10 remains objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Amendment***

9. Applicant's arguments filed 12 APR 2007 have been fully considered but they are not deemed to be persuasive.

With regard to the rejections under 35 U.S.C 103, as recently explained in *KSR Int'l. Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (2007), "the problem motivating the patentee may be only one of many addressed by the patent's subject matter. The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." The Supreme Court further elaborates that "[c]ommon sense



Art Unit: 1723

teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle."

Accordingly, from the disclosures of Pickels et al. (US 2,878,992) and WO 00/58013, one skilled in the art would have found it obvious and utter common sense to have utilized any of the alternative sample vessels outlined by WO '013 (including microtitre plates) in the analogous centrifuge of Pickels.

It is clear from the arguments filed 12 APR 2007 that Applicant believes the claims are more limited in scope than a reexamination reveals. Applicant infers that the heat exchange medium (such as air) comes into direct contact with the sample vessels, yet it is noted amended claim 1 merely recites "for directing ambient gas to pass in heat exchange relationship" with the sample vessel. This claim language does not preclude one or more intervening elements to be interposed between the air flow and the sample vessels (such as the rotor mass seen in Fig. 5 of Pickels). Note Pickels teaches at col. 3, lines 20-22 that the rotor is cooled by the flow of air, hence, via the laws of heat exchange, the contents of the rotor would be cooled as well (such the sample vessels and the contents thereof). The examiner believes the claim language "in heat exchange relationship" does not necessarily mandate that the heat exchange medium directly contact the sample vessel/microtitre plate but permits the heat exchange medium to contact one or more intermediate elements (such as the rotor of Pickels) that are in contact with the sample vessel/microtitre plate.

Applicant argues that the heat exchange effect in Pickels would be too slow to migrate through the block of the rotor, yet the examiner notes the instant application is devoid of any time parameters. Accordingly, such arguments regarding the heat exchange medium directly contacting the sample vessel/microtitre plate and the time to achieve temperature change are of no patentable consequence because it is well settled that features not claimed may not be relied upon in support of patentability. *In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982). Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

Furthermore, Applicant remarks that the movement of air in Pickels would not make it possible to cool and heat in a cyclic manner through the metal block of the rotor means. This statement directly contradicts Pickels at col. 3, lines 20-22 and Applicant's position on this point is considered to be speculative attorney's argument unsupported by objective technical evidence on the issue. Arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). The fact that one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to such person that the something is a

part of the appellants' disclosure. See *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1064 (1978).

The blades 71 and 83 of Pickels can be termed "fan blades" within the broad scope of the term since these blades are set into motion via rotation of the rotor means and directly contact and thus influence movement/impelling of the ambient air, at least to some degree. Since the blades 71 are in contact with the rotor, these blades function to impel the movement of air (again, at least to some degree by the impact between the rotating blades 71 and the surrounding air) and act as heat exchange blades/fins as well to cool the rotor. Hence, Applicant's conclusion that the blades in Pickels are not equivalent to the very broadly recited fan blades is not a compelling argument.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE

Art Unit: 1723

MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION. ANY RESPONSE FILED AFTER THE MAILING DATE OF THIS FINAL REJECTION WILL BE SUBJECT TO THE PROVISIONS OF MPEP 714.12 AND 714.13.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley whose telephone number is (571) 272-1139. The examiner can normally be reached on Mon-Fri.. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Charles E. Cooley  
Primary Examiner  
Art Unit 1723

5 July 2007